

It is Applicant's understanding that the Examiner has not yet reviewed Applicant's office action response made February 7, 2002 in response to the Office Action mailed November 30, 2001. Applicant respectfully requests that the Examiner review the claims in light of Applicant's arguments made in Applicant's office action response of February 7, 2002 inasmuch as the amendments made herein do not alter said arguments of Applicant. Applicant respectfully submits that the present patent application is in condition for allowance.

Applicant hereby presents the present Supplemental Amendment in conjunction with a Request by Applicant for an interference pursuant to 37 CFR § 1.607 wherein Applicant respectfully requests that an interference be declared between the present patent application ("Montena 09/621,975 Patent Application" or "Montena Patent") and the United States Patent Number 5, 997,350 ("Burris 5,997,350 Patent" or "Burris Patent"). The information required by 37 CFR § 1.607(a) is set forth as follows to facilitate consideration by the Examiner.

**I. Patent Having Claims That Interfere With Claims of the Montena Application**

The patent having claims that interfere with the Montena Application is United States Patent Number 5, 997,350, namely the Burris Patent, which has both a filing date of June 8, 1998, an effective filing date of June 8, 1998, and an issue date of December 7, 1999. A copy of the Burris patent is submitted herewith as Appendix I.

The Montena 09/621,975 Patent Application (i.e., the "Montena Application") was filed on July 21, 2000 and is a continuation of application Serial No. 08/910,509 ("the parent application"), which was filed on August 2, 1997 and issued November 28, 2000 under patent number 6,153,830. Thus, the Montena Application has an earlier effective filing date than does

the Burris Patent. Accordingly, Applicant has provided a statement in Appendix H, in accordance with 37 C.F.R. § 1.608(a), alleging that there is a basis upon which Applicant of the Montena Application is entitled to judgment relative to the patentee of the Burris Patent.

Applicant also wishes to bring to the Examiner's attention certain related co-pending design applications, all of which were filed on April 28, 2000. The serial numbers for the co-pending design applications are: 29/122,505; 29/122,506; 29/122,508 and 29/122,509.

**II. Presentation of a Proposed Count and Claims of the Burris Patent and Montena Application Corresponding To The Count**

Appendix B specifies six counts for the interference, and claims corresponding to the counts, as follows:

Count	Claims Corresponding To The Count	
	Burris Patent	Montena Application
1	1	2, 15-22
2	3	4
3	4	6
4	5	8
5	6	10, 11, 12
6	7	13, 14

**III. Claims Corresponding To the Count Do Not Correspond Exactly To the Count**

The six counts are phantom counts in part because of the different language utilized by the Burris Patent and Montena Application to describe the same invention.

Applicant submitted a preliminary amendment on September 11, 2000 (hereinafter

“Preliminary Amendment” and incorporated herein by reference in its entirety including Exhibit A, Exhibit B, Exhibit C, and Exhibit D) which presented claims 2-14 for the purpose of invoking an interference with the Burris Patent, wherein said claims 2-14 corresponded exactly or substantially to claims 1, 3, 4, 5, 6, and 7 of the Burris patent. The preliminary amendment of September 11, 2000 provided the required support and arguments for the interference.

Nonetheless, an interference has not been possible, because the Examiner of the Montena Application initially rejected claims 2-14 based on prior art and, after two iterations of claim amendments which have amended all claims except claim 4, has allowed only claims 13-14 and has maintained the rejection of all other claims. Applicant respectfully believes that all claims in their present form are allowable. Thus, the claims of the Montena Application submitted by preliminary amendment are considered by the Examiner to be invalid for essentially the same claims in the Burris Patent that are presumed to be valid. Therefore, the differences in language utilized by the Burris Patent and Montena Application to describe the same invention are primarily the result of amendments to the Montena Application needed to overcome the prior art cited by the Examiner.

Nonetheless, the current claims of the Montena Application (corresponding to the counts) and the claims of the Burris Patent (corresponding to the counts) describe the same invention as will be explained *infra*.

Additionally, the claims of the Montena Application and the Burris Patent presented herewith as corresponding to the counts do indeed correspond to the counts as will be explained *infra*.

**IV. Application of Terms of Montena Application To Disclosure of Montena Application**

Appendices C and D apply the terms of the claims of the Montena application, corresponding to the counts, to the disclosure of the Montena Application including to the drawings and the specification of the Montena Application.

**V. 35 U.S.C. § 135(b) is Satisfied**

Claims 2-14 submitted by Applicant via said Preliminary Amendment on September 11, 2000, for the purpose of invoking an interference with the Burriss Patent, were submitted within one year of the issue date of December 7, 1999 of the Burriss Patent as required under 35 U.S.C. § 135(b). The preliminary amendment of September 11, 2000 provided the required support and arguments for the interference, demonstrating that the claims of the Montena Application and the corresponding claims of the Burriss Patent are directed to the same invention. According to the Examiner, however, the claims of the Montena Application submitted by preliminary method were not patentable due to prior art. To overcome the prior art rejections, all of the current claims of the Montena Application corresponding to the count, with the exception of claim 4, have been amended on a date that exceeds one year following the issue date of December 7, 1999 of the Burriss Patent. Nonetheless, the current claims of the Montena Application are for the same subject matter directed to the same patentable invention as are the claims of the Montena Application submitted via preliminary amendment on September 11, 2000 as will be explained *infra*.

If (hypothetically) the currently amended claims of the Montena Application were not directed to the same invention as the claims submitted by preliminary amendment on September

11, in light of the fact that the claims of the Montena Application submitted by preliminary amendment were exactly or substantially the same as the corresponding claims of the Burris Patent, Applicant should not be denied the right to have an interference proceeding with the Burris patent for the following reason. The claims of the Burris Patent, although presumed to be valid, are in fact either valid or invalid. If the claims of the Burris Patent are valid, then the Examiner erred in rejecting the claims of the Montena Application and erroneously required Applicant to amend the claims beyond one year after December 7, 1999 in order to distinguish the prior art when in fact no such amendments were needed, a situation entirely under control of the Examiner in which Applicant has no alternative but to amend the claims. If the claims of the Burris Patent are invalid, however, then the invalidity of the claims has forced Applicant to amend claims beyond one year after December 7, 1999 in order to have valid claims. Thus, the Burris Patent achieves "interference immunity" by having invalid claims whereas the Burris Patent would have to face an interference proceeding if its claims were valid. Thus, either the Examiner has erroneously prevented Applicant from having an interference proceeding or invalid patent claims have shielded the Burris patent from being in a interference proceeding, which seems both irrational and inequitable. Furthermore, Applicant maintains that it is contrary to public policy for the Burris Patent to gain immunity from an interference challenge merely because of having invalid claims and thus be "rewarded" (and Applicant correspondingly punished) for having invalid claims, whereas the Burris Patent would be subject to an immunity challenge if its claims were valid. Applicant maintains that it is public policy to encourage a applicant/patentee to draft valid claims and not to draft invalid claims.

In summary, if (hypothetically) the currently amended claims of the Montena Application

should be found to not be directed to the same invention as the claims submitted by preliminary amendment on September 11, then Applicant respectfully maintains that the Montena Application should not be barred by 35 U.S.C. § 135(b) from having an interference proceeding with the Burris patent regardless of whether the Burris patent claims are valid or invalid. The essential point is that Applicant in good faith submitted essentially copied claims from the Burris Patent prior to a year after the issue date of the Burris patent, and Applicant was involuntarily required to amend the claims of the Montena application following one year from the issue date of the Burris patent in order to distinguish over the prior art and thus meet a threshold requirement for initiation of an interference, wherein the deviations of the present claims of the Montena Application from the essentially copied claims of the Burris patent are directed predominantly to overcoming the prior art based on the Examiner's interpretation of the prior art.

**VI. The current claims of the Montena Application are for the same the same subject matter directed to the same patentable invention as are the corresponding claims of the Montena Application submitted via preliminary amendment on September 11, 2000.**

Appendix G shows current claims of the Montena Application ("Current Claims") as marked up relative to the same claims submitted by preliminary amendment on September 11, 2001 ("Prior Claims"). The primary differences between the Current Claims and the Prior Claims are as follows, wherein the relevant language in the Current Claim is shown as marked up from the Prior Claim, and wherein all such differences relating to claim 2 also relate to claims 4, 6, and 8 which depend from claim 2, and wherein C $\alpha$  stands for claim C and claim element  $\alpha$  (e.g., "claim 2c" stands for claim 2, element c).

In claim 2c and 2d (and similarly in claims 8, 10c, 10d, 11c, 11d, 12c, and 12d), "first

predetermined diameter” in the Prior Claim has been replaced by “first diameter” in the Current claim. This change is within the scope of the same patentable invention.

In claim 2d, “at least a portion of” has been added to form the following language in the Current Claim: “the first end of said compression ring having at least a portion of a first internal bore of a diameter commensurate with the first diameter of the outer wall of said cylindrical sleeve.” This change is within the scope of the same patentable invention.

In claim 2d (and similarly in claims 10d, 11d, and 12d), “extend over” in the Prior Claim has been replaced by “axially slidably engage” in the Current Claim which states “the first end of said compression ring to [extend over] axially slidably engage the first end of said cylindrical body member.” This change was made to make claim 2 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 2e (and similarly in claims 8, 10c, 10d, 11c, 11d, 13c, and 13d), “open” has been added to form the following language in the Current Claim: “said open rear end portion of said cylindrical sleeve to be deformed inwardly toward said tubular post.” This change is within the scope of the same patentable invention.

In claim 13c, the “deformable” has been replaced in the Current Claim which to form the following language in the Current Claim: “said open rear end portion being [deformable] deformed inwardly toward said tubular post and against the jacket of the coaxial cable when a compression ring is advanced axially over the first end of said cylindrical body member.” This change is within the scope of the same patentable invention.

Based on the preceding analysis, Applicant respectfully maintains the Current Claim is within the scope of the same patentable invention as the Prior Claim for claims 2, 4, 6, 8, and 10-

14.

**VII. Current Claims 15-22 of the Montena Application are for the same the same subject matter directed to the same patentable invention as is Prior Claim 2 of the Montena Application submitted via preliminary amendment on September 11, 2000.**

The preceding Section VI demonstrated that Current Claim 2 is within the scope of the same patentable invention as the Prior Claim 2. Claims 15-22 are each similar to claim 2 and various tables in Appendix F contrast the language of Current Claims 15-22 with the language of Current Claim 2. From these tables in Appendix F, the primary differences between the Current Claims 15-22 and the Current Claim 2 are as follows, wherein the relevant language in the Current Claims 15-22 are shown as marked up from the Current Claim 2, and wherein all such differences relating to claim 2 also relate to claims 4, 6, and 8 which depend from claim 2, and wherein C $\alpha$  stands for claim C and claim element  $\alpha$  (e.g., “claim 2c” stands for claim 2, element c).

In claim 15c, the following language has been added: “wherein the axial length of the cylindrical sleeve is less than the axial length of the first end of said tubular post.” This change was made to make claim 15 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 16d, the following language has been added: “wherein the first internal bore is without helical threads.” This change was made to make claim 16 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 17d, the following language has been added: “wherein the first internal bore is a



substantially smooth bore.” This change was made to make claim 17 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 18d, the following language has been added: “wherein the axial length of the central passageway of the compression ring is approximately equal to or less than the axial length of the first end of said tubular post.” This change was made to make claim 18 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 19d, the following language has been added: “wherein the axial length of the first internal bore is less than the axial length of the first end of said tubular post.” This change was made to make claim 19 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 20d, the following language has been added: “wherein the axial length of the first internal bore is less than the axial length of the deformable rear end portion of the cylindrical sleeve.” This change was made to make claim 20 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 21d, the following language change has occurred from Current Claim 2 to Current Claim 21: “the first end of said compression ring having [at least a portion of] a first non-tapered internal bore of a diameter commensurate with the first diameter of the outer wall of said cylindrical sleeve.” This change was made to make claim 21 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

In claim 22d, the following language change has occurred from Current Claim 2 to

Current Claim 22: "the first end of said compression ring having [at least a portion of] a first constant diameter internal bore of a diameter commensurate with the first diameter of the outer wall of said cylindrical sleeve." This change was made to make claim 22 patentably distinct with respect to the prior art cited by the Examiner, but is within the scope of the same patentable invention.

Based on the preceding analysis, Applicant respectfully maintains the Current Claims 15-22 are within the scope of the same patentable invention as the Current Claim 2, and making use of the preceding analysis of Section VI which demonstrated that Current Claim 2 is within the scope of the same patentable invention as the Prior Claim 2, Applicant respectfully conclude that Current Claims 15-22 are within the scope of the same patentable invention as the Prior Claim 2.

**VIII. The Current Claims of the Montena Application (corresponding to each count) and the claims of the Burris Patent (corresponding to the count) are for the same the same subject matter directed to the same patentable invention.**

Claims 2-14 submitted by Applicant via said Preliminary Amendment on September 11, 2000 provided the required support and arguments for the interference, demonstrating that the claims of the Montena Application and the corresponding claims of the Burris Patent are directed to the same invention. Of particular relevance is a segment of the Preliminary Amendment comprising page 11, line 16 (beginning with the sentence "Claims 2-14 of the captioned application are clearly supported by the specification as originally filed.") - page 24, line 5 (ending with the sentence "Therefore, Applicant believes that new claim 14 is allowable and should be considered as the basis for an interference with claim 7 of the Burris patent."). Said segment of the Preliminary Amendment describes the features of claims 2, 4, 6, 8, and 10-14 and

shows where in the specification of the Montena Application each of said claim features are disclosed. Additionally, said segment of the Preliminary Amendment includes a table on page 13, line 21 - page 14, line 18 (preceding the paragraph beginning with "New claim 3 is clearly ...), wherein said table discloses the different language used to label the same claim features of claim 1 of the Burriss Patent and Claim 2 of the Montena Application. Said table also discloses the reference numerals associated with said claim features. Also, Appendix E herein applies the terms of the claims of the Burriss Patent, corresponding to the counts, to the drawings of the Montena Application. In addition, said Preliminary Amendment presents claim charts in Exhibit B comprising side by side comparisons of: Montena Application claims 2, 4, 6, 8, 10-12, and 13-14 with Burriss Patent claims 1, 3, 4, 5, 6, and 7, respectively.

Thus, the Montena Application demonstrated that the following claim groupings are directed to the same patentable invention: Burriss Patent claim 1 and Montena Application claim 2; Burriss Patent claim 3 and Montena Application claim 4; Burriss Patent claim 4 and Montena Application claim 6; Burriss Patent claim 5 and Montena Application claim 8; Burriss Patent claim 6 and Montena Application claims 10-12; and Burriss Patent claim 7 and Montena Application claim 13-14. Therefore, each of said claim grouping provides a basis for a phantom count formed relating the claim components in each claim grouping by a logical OR in the associated phantom count. Accordingly, the preceding claim grouping provide a basis for the six counts proposed herein.

The preceding analysis in this section VIII is now combined with the analysis *supra* of sections VI and VII to lead to the conclusion that the Current Claims of the Montena Application (corresponding to each count) and the claims of the Burriss Patent (corresponding to the count)

are for the same the same subject matter directed to the same patentable invention. Section VI demonstrated that the current claims of the Montena Application are for the same the same subject matter directed to the same patentable invention as are the corresponding claims of the Montena Application submitted via said Preliminary Amendment on September 11, 2000. Section VII demonstrated that the Current Claims 15-22 of the Montena Application are for the same the same subject matter directed to the same patentable invention as is Prior Claim 2 of the Montena Application submitted via said Preliminary Amendment on September 11, 2000. As additional support for said conclusion, Appendix F herein comprises claim charts showing the differences between the claims of the Montena application, corresponding to the counts, and the claims of the Burris Patent, wherein said differences have been discussed *supra*.

**IX. The Current Claims of the Montena Application and the claims of the Burris Patent, presented herein as corresponding to the count, do indeed correspond to the count.**

The analysis of Section VII concluded that the Current Claims of the Montena Application (corresponding to each count) and the claims of the Burris Patent (corresponding to the count) are for the same the same subject matter directed to the same patentable invention. Since the six phantom counts proposed herein are derived by applying a logical OR operator between Burris Patent claims and Montena Application claims for the same the same subject matter directed to the same patentable invention, it follows that the Current Claims of the Montena Application and the claims of the Burris Patent, presented herein as corresponding to the count, do indeed correspond to the count. For additional support, Appendix F presents claim charts showing the differences between the claims of the Montena application, corresponding to

the counts, and the counts themselves.

### SUMMARY AND CONCLUSION

Applicant respectfully submits that the application is in condition for allowance. In summary, Applicant respectfully requests: (1) that all pending claims in the present patent application be indicated as allowable; (2) that an interference be declared between the Montena Application and the Burris Patent; and (3) that the interference be based on the proposed counts, and the claims corresponding to the counts, listed in Appendix B.

Should the Examiner believe that anything further is necessary to place the application in better condition for allowance or to facilitate an initiation of the interference, the Examiner is respectfully requested to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,

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